



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,559	01/04/2002	Douglas Fenwick	28809.0002	7146

7590 05/20/2003

Kevin D. McCarthy  
Hodgson Russ LLP  
Suite 2000  
One M&T Plaza  
Buffalo, NY 14203-2391

EXAMINER

FLANDRO, RYAN M

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 05/20/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/038,559

Applicant(s)

FENWICK ET AL.

Examiner

Ryan M Flandro

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-24 is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's arguments (see paper no. 3, pages 12-23) filed 25 February 2003, with respect to the rejection(s) of claim(s) 1-16 under 35 U.S.C. §103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Cantley (US 6,470,643) (Cantley II) set forth below.

#### ***Claim Rejections - 35 USC § 112***

2. The rejection of claims 1-16 under 35 U.S.C. §112, second paragraph, set forth in the previous Office action, is hereby withdrawn in light of Applicant's amendment submitted 25 February 2003 (paper no. 4).

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 17-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification and drawings provide that "[t]he extensions 14, 16 can also be of any design. The design can have a concave surface, planar as shown in figure 2, or convex as shown in figure 5." Nevertheless, the original disclosure does not provide support for the first extension having differently shaped surfaces on its top and

Art Unit: 3679

bottom surfaces in one embodiment as recited in claims 17 and 18 (see also paragraph 6 below).

Likewise, the original disclosure does not provide support for the second extension having differently shaped surfaces on its top and bottom surfaces in one embodiment as recited in claims 17 and 19 (see also paragraph 6 below).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18 and 19 are further rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the additional limitations of claims 18 and 19 (e.g., the top surface of the first extension is transversely convex – lines 2-3 of claim 18) conflict with those recited in claim 17 (e.g., the top surface of the first extension is flat – lines 12-13 of claim 17) from which they depend. The resulting conflict renders the scope of the claim indefinite since additional limitations in dependent claims *merely add to the structure* of the independent claim (i.e., additional limitations in dependent claims *do not replace* previously recited limitations in the independent claim).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Cantley (US 6,470,643) (Cantley II).

a. Claim 1. Cantley II shows and discloses a polymeric lattice fence **100** comprising a unitary polymeric structure **100** having a framework of at least one first extension **102** and at least one second extension **104**, the first and second extensions **102,104** appear to cross one another at a juncture **130**, the first and the second extensions **102,104** appear to cross over each other at different angles to form a network of apertures between the extensions **102,104**; the first and second extensions **102,104** each having a length, a width, two side edges **110,112,122,124**, and a depth that are the same or distinct. Further, Cantley II shows a juncture **130** where the first and second extensions **102,104** appear to cross over each other, at least 50% to 95% of the depth of each side edge **110,112,122,124** is exposed and the remaining portion of the depth of each side edge **110,112,122,124** is merged with the other extension **102,104**. (See figure 14-16; column 2 lines 39-54; column 6 line 10 – column 8 line 35).

b. Claim 9. Cantley II, as applied in subsection 3(a) above, includes all of the limitations of claim 9 as well as the method of manufacturing the unitary polymeric

lattice fence **100** comprising injecting a polymeric material into a mold having a predetermined shape (figure 17; column 7 line 53 – column 8 line 5).

c. Claims 2 and 10. Cantley II, as applied above, shows the [amount of side edge **58** exposed] is about 80% [of the total depth] (see figures 14-16).

d. Claims 4 and 12. Cantley II further discloses that the first and second extensions **102,104** are at an obtuse angle to each other (column 8 lines 32-35).

e. Claims 5 and 13. Cantley II further discloses that the first and second extensions **102,104** are at a right angle to each other (column 8 lines 32-35).

f. Claims 6 and 14. Cantley II further discloses that the first and second extensions **102,104** are at an acute angle to each other (column 8 lines 32-35).

g. Claims 7 and 15. Cantley II further shows that the apertures are four-sided polygons (see figure 1).

h. Claims 8 and 16. Cantley II further shows that the apertures are defined by a continuous curvilinear line (see figure 1).

### ***Claim Rejections - 35 USC § 103***

9. Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cantley II, as applied above, in view of Cowan (US 5,865,427). Cantley II, as applied above, discloses all the limitations of claims 3 and 11, including that the lattice is formed of plastic (column 7 line 54), but does not explicitly state that the polymeric material is polyethylene.

a. Cowan, however, teaches that it is common to form such plastic fencing from polyethylene (column 2 lines 34-38).

Art Unit: 3679

- b. Additionally, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 U.S.P.Q. 416, 417-18 (CCPA 1960).
- c. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made modify the plastic lattice fence of Cantley II by providing that it be made specifically of polyethylene as taught by Cowan.

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection. Nevertheless, for future reference, the Examiner also wishes to point out to Applicant's Representative that a rejection under 103(a) applying only one reference does not necessarily suggest that the Examiner combined his/her personal knowledge with the sole reference in order to generate a rejection. Rather, because the sole reference did not explicitly disclose each and every limitation, the Examiner merely recognized that a rejection under 35 U.S.C. §102 was not proper and that any explanation of obviousness in light of relevant case law must be made under §103.

### ***Allowable Subject Matter***

11. Claim 17 would be allowable if Applicant can overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action. At the same time, claims 18 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second

Art Unit: 3679

paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 20-24 are allowed.

13. The following is a statement of reasons for the indication of allowable subject matter:

a. Claims 17-19. The prior art, including Cantley and Cantley II, fails to show or disclose, either alone or in combination, a space defined between the concave bottom surface of the first extension and the flat top surface of the second extension. Because claims 18 and 19 depend from claim 17 and, therefore, they are indicated as allowable for the same reasons.

b. Claims 20-24. The prior art, including Cantley and Cantley II, fails to show or disclose, either alone or in combination, fill between the first and second extensions, the fill for forming the curvilinear shaped apertures. Claims 21-24 depend from claim 20 and, therefore, they are indicated as allowable for the same reasons.

### *Conclusion*

14. This action is **NON-FINAL** due to the new grounds of rejection set forth above.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952.

The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.



Art Unit: 3679

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ryan M. Flandro  
May 15, 2003

A handwritten signature in black ink, appearing to read 'LH Browne', is positioned above the printed name.

**Lynne H. Browne**  
***Supervisory Patent Examiner***  
**Technology Center 3670**